



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,693	12/13/2000	John Archer	CITI0140	6527

75127 7590 01/15/2008
KING & SPALDING LLP (CITI CUSTOMER NUMBER)
ATTN: GEORGE T. MARCOU
1700 PENNSYLVANIA AVENUE, NW
SUITE 200
WASHINGTON, DC 20006

EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
----------	--------------

3694

MAIL DATE	DELIVERY MODE
-----------	---------------

01/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/734,693

Applicant(s)

ARCHER ET AL.

Examiner

Ella Colbert

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-30 are pending. Claims 2 and 17 has been amended in this communication filed 11/01/07 entered as Response After Non-Final Action.
2. The Correspondence Address Change filed 11/05/07 has been entered.
3. The claim objection for claims 2 and 17 has been overcome by Applicant's amendment.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 10-16 and 25-30 are rejected under 35 U.S.C. 102(b) as being anticipated by (US 5,995,979) Cochran.

As per claim1, Cochran discloses, A method of searching financial transactions against a server-resident matchable text pattern file of sanctioned entities using a network, the network including a plurality of servers accessible by a plurality of user terminals, comprising: inputting at one of the plurality of user terminals a search request text pattern for searching the server-resident matchable text pattern file of sanctioned entities, the search request text pattern including a text string, the text string further including one or more regular expression operators, including letters, digits or punctuation marks to further define the search request text pattern and to further identify a server being invoked among the plurality of servers (col. 7, line 9- col. 8, line 44 and

fig. 2); storing the search request text pattern as an entry in a search request instruction file, the search request instruction file being accessible by a server processor (col. 6, lines 6-10); transmitting the search request instruction file to the server processor invoked via the network (col. 6, lines 40-42, fig. 2); the server processor checking the search request text pattern, the checking including determining a match of the search request text pattern against the matchable text pattern file of sanctioned entities in the server (col. 6, lines 44-47); and upon execution of the search, transmitting search results to the one of the plurality of user terminals via the network (col. 7, line 55- col. 8, lines 65 and fig. 2 (42)).

As per claim 10, Cochran discloses, The method according to claim 1, further comprising: generating a user authorization code at the time the terminal user inputs a text pattern selection for checking against a sanctioned entity database (col. 6, lines 45-50); and storing the authorization code with the text pattern selection in the search request instruction file, wherein the authorization code must be received in order to access the server (col. 6, lines 53 - col. 7, lines 4).

As per claim 11, this dependent claim is rejected for the similar rationale as above for claim 10.

As per claim 12, Cochran discloses, The method according to claim 1, wherein matchable text pattern files are replicated between each server via the network (col. 5, line 49-col. 6, line 5 and fig. 1).

As per claim 13, Cochran discloses, The method according to claim 12, wherein matchable text pattern files are mutually updating via the network (col. 3, lines 45-52 and col. 8, lines 54-65).

As per claim 14, Cochran discloses the invention substantially as claimed with the exception of the server failure automatically routes search request instruction files to an alternate server. However, since Cochran discloses a communication link between users and remote servers in the communication network, the feature that the server failure automatically routes the search request instruction files to an alternate server is inherent in the system in order to retrieve a search result.

As per claim 15, Cochran discloses, The method according to claim 1, wherein the search request instruction file is generated by a computer program (col. 5, lines 56-64).

As per claim 16, this independent claim is rejected for the similar rationale as given above for corresponding claim 1. Corresponding claim 1 claims a method with steps that correspond to the system steps of claim 16.

As per claim 25, this dependent claim is rejected for the similar rationale as given above for corresponding claims 10 and 11.

As per claim 26, this dependent claim is rejected for the similar rationale as given above for corresponding claims 10, 11, and 25.

As per claim 27, this dependent claim is rejected for the similar rationale as given above for corresponding claim 12.

As per claim 28, this dependent claim is rejected for the similar rationale as given above for corresponding claim 13.

As per claim 29, this dependent claim is rejected for the similar rationale as given above for corresponding claim 14.

As per claim 30, this dependent claim is rejected for the similar rationale as given for corresponding claim 15.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-5 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,995,979) Cochran in view of "Compliance Solutions".

As for claims 2 and 17, Cochran failed to disclose, The method according to claim 1, wherein the server-resident matchable text pattern file includes the OFAC sanction list. "Compliance Solutions" teaches, The method according to claim 1, wherein the server-resident matchable text pattern file includes the OFAC sanction list (page 2). "Compliance Solutions" did not expressly disclose, "a server". However, Cochran discloses, a server (col. 6, lines 1-5 and fig. 1 (710) for matching a text pattern file list. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Cochran's server-resident matchable text pattern file that includes a list with "Compliance Solutions" OFAC sanction list because this would

allow Cochran to know that the institution sending and receiving payments to a person or entity is on the master list issued by OFAC in order to avoid paying a fine.

As per claims 3 and 18, Cochran discloses, The method according to claim 2, wherein servers are located in different countries (col. 6, lines 11-23 and fig 1 (750) – Internet).

As per claims 4 and 19, Cochran discloses, The method according to claim 3, wherein the server includes a plurality of matchable text pattern files including user defined sanction lists (col. 1, lines 30-37 and col. 8, lines 45-53).

As per claims 5 and 20, Cochran discloses, The method according to claim 4, wherein the search request instruction file further defines the matchable text pattern files to be searched (col. 6, lines 6-10).

8. Claims 6-9 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,995,979) Cochran and “Compliance Solutions” in view of (US 5,842,219) High, Jr. et al, hereafter High, Jr.

As per claim 6, Cochran and “Computer Solutions” failed to disclose, The method according to claim 1, further comprising: defining sanctioned entities as matchable text patterns; storing matchable text patterns as individual phrases; arranging individual phrases as a letter tree array; generating a search node for each character in the search request text pattern to be checked against matchable text patterns; comparing search nodes against characters and positions in the letter tree array; and determining whether a match occurs. High, Jr. discloses, defining sanctioned entities as matchable text patterns (col. 2, lines 35-51); storing matchable text patterns as

individual phrases; arranging individual phrases as a letter tree array (col. 3, lines 37-47); generating a search node for each character in the search request text pattern to be checked against matchable text patterns (col. 5, line 65-col. 6, line 9 and fig. 4A); comparing search nodes against characters and positions in the letter tree array; and determining whether a match occurs (col. 6, lines 10-35 and fig. 4B). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Cochran in view of Cochran's teachings of multiple lists of search terms and matching text patterns and because such a modification would allow Cochran to have an enhanced search capability within a object-oriented distributed computing network.

As per claim 7, Cochran and "Computer Solutions" failed to disclose, The method according to claim 6, wherein the search request instruction file includes a spell correct flag to include spelling variations of the search request text pattern to be checked against the matchable text pattern file. High, Jr. discloses, the search request instruction file includes a spell correct flag to include spelling variations of the search request text pattern to be checked against the matchable text pattern file (col. 5, lines 14-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Cochran because such a modification would allow Cochran to compare the temporary index in order to remove the coexisting property names from the property name list and to build a new temporary list of correct spelling variations of the text pattern and to append it to the existing index.

As per claim 8, Cochran and "Computer Solutions" failed to disclose, The method according to claim 6, wherein the search request instruction file includes a missing

letters flag to include missing letters in the text pattern to be checked against the matchable text pattern file. High, Jr. discloses, the search request instruction file includes a missing letters flag to include missing letters in the text pattern to be checked against the matchable text pattern file (col. 6, lines 16-35 and fig. 4A). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Cochran because such a modification would allow Cochran to have comparison operations, logical operations, and set operations to be performed to check the text pattern against the matchable text pattern.

As per claim 9, Cochran and "Computer Solutions" failed to disclose, The method according to claim 6, wherein the search request instruction file includes a transposed letters flag to include transposed letters in the text pattern to be checked against the matchable text pattern file. High, Jr. discloses, the search request instruction file includes a transposed letters flag to include transposed letters in the text pattern to be checked against the matchable text pattern file (col. 5, lines 14-19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Cochran because such a modification would allow Cochran to have the capability to determine when letters are transposed in the text pattern of the searchable matchable text pattern.

As per claim 21, this dependent claim is rejected for the similar rationale as above for corresponding claim 6.

As per claim 22, this dependent claim is rejected for the similar rationale as given above for corresponding claim 7.

As per claim 23, this dependent claim is rejected for the similar rationale as given above for corresponding claim 8.

As per claim 24, this dependent claim is rejected for the similar rationale as given above for corresponding claim 9.

Response to Arguments

9. Applicant's arguments filed 11/01/07 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: The 102 (b) rejection under Cochran is respectfully traversed because the only difference in the rejection is the change from 103(a) to 102 (b) and seems to be identical and does not address the arguments in the Appeal Brief that caused the Examiner to reopen prosecution and the Appeals conferees were not persuaded to change the reference but decided that the rejection should have been a 35 USC102. Also, Applicants' argue: Cochran does not disclose "searching financial transactions", sanctioned entities", and "identifying the server being invoked among the plurality of servers" has been considered but is not considered persuasive. Response: In response to applicant's arguments, the recitation "searching financial transactions" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re*

Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

As for "sanctioned entities" and "identifying the server being invoked among the plurality of servers", the "sanctioned entities" are interpreted at being "the subset of records stored or marked at the server" in col. 6, lines 44-47 and "identifying the server being invoked among the plurality of servers" as being in Fig. 1 –the display of the records indicates that a server has been invoked from among the other servers. It is well-known in the art of networking and Internets that a network (Internet) has many servers in its construction because a network (Internet) is a network of multiple computer terminals and servers. Reference can be had to Col. 6, lines 1-5 support this well-known fact. It cannot be determined from the claim language who or what identifies and invokes the server from the plurality of servers and who or what is doing the inputting at the plurality of user terminals. Is a person (a user) doing the inputting or is an automatic device doing the inputting? Where is the search request text pattern being stored? There are a lot of unclear claim limitations in the body of the independent claims.

Issue no. 2: Applicants' argue: "Compliance Solutions" does not teach or suggest the deficiencies of Cochran in claims 2-5 and 17-20 are not obvious in view of the cited references and claims 6-9 and 21-24 and "compliance Solutions" and High do not teach or suggest the deficiencies of Cochran, claims 6-9 and 21-24 are not obvious in view of the cited references has been considered but is not persuasive. Response: Note that KSR forecloses the argument that a specific teaching is required for a finding

of obviousness. KSR, 127 S. CT. at 1741, 82 USPQ2d at 1396. The arguments regarding Cochran has been discussed above in Issue no. 1 and there is not any need to readdress them again. As for High and "Compliance Solutions" not teaching or suggesting the deficiencies of claims 2-9 and 17-24 it is interpreted that High and "Compliance Solutions" teach and disclose the claim limitations that Cochran failed to disclose.

The Examiner is entitled to give limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).<

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Application/Control Number:
09/734,693
Art Unit: 3694

Page 12

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Wednesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 9, 2008


ELLA COLBERT
PRIMARY EXAMINER